

### REMARKS

Claim 1-14, 16-17, and 19-27 are pending in this application. Claims 1 and 23 are amended herein. Claim 27 is newly added.

#### The Rejection Under 35 U.S.C. § 112

Claims 1-2, 4-14, 16-17 and 19-22 are rejected under 35 U.S.C. § 112, second paragraph in paragraph 4 of the Office Action as being indefinite. The Office Action states it is not clear how in a single step the eyeglasses are retrieved from the case, since the first step would be to open the eye glass case by depressing the button by a hand or member and after the case is open the second step would be to retrieve the eye glass from the case.

Claim 1 is amended herein to substantially recite the upper cover 2 is opened upwardly away from the lower cover 3 to allow the contents within the case 2 to be directly retrieved in a single step by the same hand or member after depressing the button 4. (Reference is being made to preferred embodiments of the invention illustrated in the drawings of the present application). It is respectfully submitted that any lack of clarity is cured by the amendment herein. Reconsideration and withdrawal of the rejection are respectfully requested.

#### The Rejections Under Prior Art

1. Claims 1 and 10-12 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,170,651 ("Taormina") in paragraph 6 of the Office Action.

2. Claims 8-9 and 21 are rejected under 35 U.S.C. §103(a) as being obvious over Taormina in paragraph 8 of the Office Action.

3. Claims 1, 8-12 and 21-23 are rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,726,004 ("Watson") in view of Taormina in paragraph 9 of the Office Action.

4. Claims 2, 4-7, 13-14, 16-17, 19-20, 22 and 24-26 are rejected under 35 U.S.C. §103(a) as being obvious over Watson and Taormina, and further in view of U.S. Publication No. 2003/0201265 ("Lin") in paragraph 11 of the Office Action.

The above rejections are addressed by the amendments to independent Claims 1 and 23. More particularly, Claim 1 is amended to additionally recite the button 4 is pressed vertically downward.

Taormina discloses an eyeglasses case in Fig. 1 which includes button 46, which is pressed *laterally inward* to release the hinged portion 28. The relative direction of motion of the button 46 and cover 28 are *not* the same as that recited in Claim 1. This is significant because the Taormina eyeglasses case 10 and that claimed in the present application must be held in one hand in *different* manner and orientation. For example the Taormina eyeglasses case 10 is held in a vertical orientation (the user's palm is facing sideways) to allow the user to press the button 46 laterally and horizontally inward in order to release the hinged portion 28 in a vertical direction. With the eyeglasses case as claimed herein the case 1 is held horizontally (the user's palm is facing upwardly and grasps the case from underneath) to release the top cover 2 and allow it to move upwardly. Neither the Watson nor Lin patents provide any disclosure which makes up for the deficiency of the Taormina patent.

Claim 23 as amended above recites more explicitly that the activator button 4 is moved in a *downward* direction when activated. Claim 23 also recites the cover 2 moves *upward* when released. As discussed above with respect to Claim 1, the relative movement of the activator button 4 and the cover 2 is in the *opposite* directions, which feature is *neither* disclosed *nor* suggested by Taormina or the other cited references.

Accordingly, it is submitted that independent Claims 1 and 23 and all claims depending therefrom are allowable over the cited prior art references.

Additionally, with respect to the dependent Claims 2, 4-7, 13-14, 16-17, 19-20, 22 and 24-26, Lin just discloses oil being positioned between internal 31 and external 32 tubes of slow pivot element 30 to dampen rotation of cover 20 on garbage bin 1 (page 2, column 2, paragraph

[0041]). There is no suggestion of arranging this pivoting mechanism of Lin on an eyeglass case. Accordingly, the only teaching of arranging components in the manner of Claims 2, 4-7, 13-20 can be found in the present application itself, so any combination of Taormina and Lin, at most, constitutes improper hindsight reconstruction in light of the disclosure in the present application.

Furthermore, as pointed out *supra*, Lin discloses oil situated between inner and outer tubes 31, 32 and fails to teach presence of oil 9 throughout an interior of a rotating member 6 and about the spring, rotor or vane 8 positioned therewithin (please see, e.g., Claim 22).

Accordingly, Lin fails to add anything to Taormina which would render obvious the invention recited in any claim.

Rejections must be based upon the objective evidence of record. *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Particular findings must be made as to the reason the skilled artisan, *with no knowledge of the claimed invention*, would have selected the components for combination in the manner claimed. See, *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. *In re Lee* at 1434. The Examiner is obliged to develop an evidentiary basis for supporting rejections. Deficiencies in the cited references cannot be remedied by conclusory statements. See, *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

In the present instance, Neither Taormina nor Lin suggests the combination of their teachings. Accordingly it is respectfully submitted that these references do not support a *prima facie* case for obviousness.

#### The New Claim

Claim 27 is newly added and is directed to the structure of the latch means and how it physically engages the cover. See e.g., Figs. 1 and 2 of the drawings wherein it can be seen that button securing portion 5 includes an arcuate convex edge which engages a corresponding concave edge of the upper cover 2. None of the cited references disclose or suggest such a feature. Accordingly, Claim 27 is also submitted to be allowable over the cited prior art.

CONCLUSION

For at least the reasons stated above all of the pending claims are submitted to be in condition for allowance, the same being respectfully requested. The fee for the additional claim introduced herein is enclosed.

Respectfully submitted

A handwritten signature in black ink, appearing to read "Adrian Calderone", written in a cursive style.

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